REMARKS/ARGUMENTS

Claims 1-24 were pending in this application. No claims have been amended, added, or canceled. Hence, claims 1-24 remain pending. Reconsideration of the subject application as amended is respectfully requested.

Claims 1-3, 11-13 and 21-24, stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the cited portions of U.S. Patent No. 6,125,126 to Hallenstål, *et al.* (hereinafter "Hallenstål) in view of the cited portions of U.S. Patent No. 5,504,804 to Widmark (hereinafter "Widmark") and further in view of the cited portions of U.S. Patent No. 6,3030,271, to Dougherty (hereinafter "Dougherty").

Claims 4-10 and 14-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hallenstål, Widmark, and Dougherty, and further in view of the cited portions of U.S. Patent No. 5,329,578 to Brennan (hereinafter "Brennan").

Claim Rejections Under 35 U.S.C. § 103(a)

The Applicants respectfully traverse the rejection of all claims because the office action has not established a *prima facie* case of obviousness.

> To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria. Specifically, the office action has not shown that the prior art teaches or suggests all the claim limitations, and the office action does not cite a reference that teaches or suggests a motivation to combine reference teachings.

With respect to claim 1, the office action correctly states that Hallenstål is silent on, "a service location register in communication with the switching center, the service location register operative to retrieve stored called termination parameters for each of the subscriber's DNs, and call information for each incoming call to a DN." The office action implies that

Widmark teaches this in its abstract. With this, the applicants disagree; Widmark says nothing about "stored called termination parameters for each of the subscriber's DNs" nor "call information for each incoming call to a DN." Thus, the office action has not satisfied the third prong of the test because the cited references no not teach all the claim limitations.

Further, the office action does not cite a reference in the prior art that provides the necessary motivation or suggestion to combine the teachings of Hallenstål with those of Widmark to achieve the Applicant's claimed invention. The Applicants note that,

> [o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(MPEP § 2143.01) However,

> [t]he examiner may take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being well-known in the art. ... If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state. ... If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.
>
> When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts **must be supported, when called for by the applicant, by an affidavit** from the examiner.

(MPEP § 2144.03, emphasis added, citing 37 CFR §1.104(d)(2)) Because no reference is cited that provides the teaching, suggestion, or motivation to combine the references, the Applicants assume the office action is relying on facts within the personal knowledge of the Examiner. The Applicants, therefore, respectfully traverse the rejection and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by 37 CFR §1.104(d)(2).

For all of the above reasons, the Applicants believe that claim 1 is allowable over the cited references. Claims 12 and 21 include similar limitation and are believed to be allowable for similar reasons. Further, since the remaining claims depend from one of these independent claims, the Applicants believe that the remaining claims also are allowable.

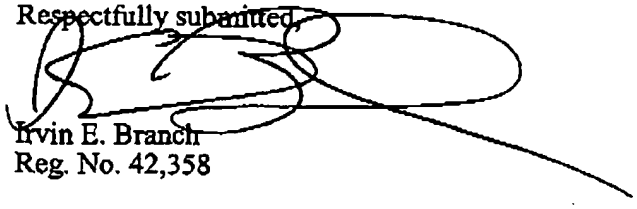
Furthermore, the applicants respectfully traverse the rejection of claim 12 because the invention of the present application and Patent 6,393,271 (Dougherty) were, at the time the invention of the present application was made, owned by a common entity. Thus Dougherty is not available as prior art in accordance with 35 U.S.C. § 103(c). Claim 12, therefore, is believed to be allowable for this additional reason.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Irvin E. Branch
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
IEB:arl
60112626 v1